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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/032,083 02/27/98 BELL

R SELS-0034

EXAMINER

TM02/1108

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ART UNIT

PAPER NUMBER

2663

DATE MAILED:

11/08/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/032,083

Applicant

Bell et al

Examiner

Huy D. Vu

Group Art Unit
2663



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-80 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-80 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Claim Rejections - 35 U.S.C. § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 13 and 33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to disclose support for the feature that the stateless signaling message received from the stateless client includes a command selected from the group consisting of light a specified lamp, display text, turn a ringer on/off, play a specified tone, associate button with specified function, and connect at least one media stream. Furthermore, it is noted that some of the above mentioned commands is disclosed as being received by a client from the server (see figure 5) rather than from the client as claimed.

Claim Rejections - 35 U.S.C. § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6, 9, 11-12, 14-26, 29, 31-32, 34-47, 50-62, 65-73, 75-78 and 80 are rejected under 35 U.S.C. 102(e) as being anticipated by Kubler et al (USP 5,726,984).

Regarding claims, 1-6, 9, 11-12, 14-26, 29, 31-32, 34-47, 50-62, 65-73, 75-78 and 80, Kubler teaches a system capable of performing state-based signaling on behalf of a stateless-client (6331) comprising a controller (6333) coupled to a state-based terminal (6301, 6303), that translates at least one stateless signaling message (telephony dialing) received from the stateless client (6331) to at least one state-based signaling message for presentation to said state-based terminal (6301, 6303) thereby facilitating a media stream communications session between said stateless client (6331) and said state-based terminal (6301, 6303) over an IP-based network (6315).

5. Claims 41-46, 50-54, 56-61, 65-69, 71-73, 75-78 and 80 are rejected under 35 U.S.C. 102(b) as being anticipated by Iwami et al (USP 5,605,737).

Regarding claims, 41-47, 50-62, 65-73, 75-78 and 80, Iwami teaches a system capable of performing state-based signaling on behalf of a stateless-client (2) comprising a controller (20) coupled to a state-based terminal (10-1, 10-2), that translates at least one stateless signaling message (telephony dialing) received from the stateless client (2) to at least one state-based signaling message for presentation to said state-based terminal (10-1, 10-2) thereby facilitating a media stream

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communications session between said stateless client (2) and said state-based terminal (6301, 6303) over an packet-based network (1).

Claim Rejections - 35 U.S.C. § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 10 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubler et al (USP 5,726,984) in view of Bruno et al (USP 5,724,355).

Kubler differs from the claims in that Kubler does not teach H.323 as a protocol for used in the state-based signaling system. However, H.323 is well standardized and its use for state-based

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signaling is well known in the art as evidenced by Bruno et al. Specifically, Bruno teaches the use of H.323 protocol to establish a multimedia connection from a state-based terminal to the Internet. Thus, it would have been obvious to one skilled in the art at the time the invention was made to apply Bruno's teaching of using H.323 protocol to establish a multimedia connection from a state-based terminal to the Internet in Kubler's system with the motivation being to facilitate the connection between a regular telephone user with a state-based terminal having ISDN connection to the Internet.

8. Claims 74 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubler et al (USP 5,726,984). Kubler differs from the claim in that Kubler does not explicitly teach the use of a gateway at the ISP to connect the Intranet and the Internet. However, such use of Intranet and a gateway to connect the Intranet and the Internet is old and well known in the art of gateway. Thus, it would have been obvious to one skilled in the art at the time the invention was made to use a gateway to connect the Intranet and the Internet in Kubler's system with the motivation being to provide a controllable connection between the Intranet and the Internet.

9. Claims 7-8, 27-28, 48-49 and 63-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubler et al (USP 5,726,984) in view of Arango (USP, 5,732,078).

Regarding claims 7-8, 27-28, 48-49 and 63-64, Kubler differs from the claim in that Kubler does not teach that a portion of the media stream traverse a path without the server. However, Arango teaches a system wherein a portion of the media stream traverse a path without the original

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server. For example, a portion of a media stream from originator 210 may reach destination 250 without going through server 224 (going through router 226 and network 260 instead of router 224 and WAN 230) while other portions of the a media stream from originator 210 goes through server 224 to reach destination 250. Such mechanism enables the system to provide a guaranteed bandwidth service for certain traffics. Thus, it would have been obvious to one skilled in the art at the time the invention was made to use Arango's teaching of enabling a portion of the media stream traverse a path without the server in Kubler's system with the motivation being to provide a guaranteed bandwidth service for certain traffics.

10. Claims 1-6, 9, 11-12, 14-26, 29, 31-32, 34-40, 47, 55, 62, 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwami et al (USP 5,605,737).

Regarding claims, 1-3, Iwami teaches a system capable of performing state-based signaling on behalf of a stateless-client (2) comprising a controller (20) coupled to a state-based terminal (10-1, 10-2), that translates at least one stateless signaling message (telephony dialing) received from the stateless client (2) to at least one state-based signaling message for presentation to said state-based terminal (10-1, 10-2) thereby facilitating a media stream communications session between said stateless client (2) and said state-based terminal (6301, 6303) over an packet-based network (1). Iwami differs from the claim in that Iwami does not teach the use of IP protocol for the packet network. However, such use of IP protocol for the packet network is old and well known in the art

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for its advantage such as enhancing the connectivity and compatibility of the packet network since IP is widely used in the globally-connected Internet.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:


(703) 308-5403 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy D. Vu whose telephone number is (703) 308-6602. The examiner can normally be reached on Tuesday - Friday from 8:00 a.m. to 4:00 p.m. The examiner can also be reached on alternate Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau T. Nguyen, can be reached on (703) 308-5340.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.


HUY D. VU
PRIMARY EXAMINER

ATTACHMENT TO AND MODIFICATION OF
NOTICE OF ALLOWABILITY (PTO-37)
(November, 2000)

NO EXTENSIONS OF TIME ARE PERMITTED TO FILE CORRECTED OR FORMAL DRAWINGS, OR A SUBSTITUTE OATH OR DECLARATION, notwithstanding any indication to the contrary in the attached Notice of Allowability (PTO-37).

If the following language appears on the attached Notice of Allowability, the portion lined through below is of no force and effect and is to be ignored¹:

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE **THREE MONTHS** FROM THE "DATE MAILED" of this Office action. Failure to comply will result in ABANDONMENT of this application. ~~Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).~~

Similar language appearing in any attachments to the Notice of Allowability, such as in an Examiner's Amendment/Comment or in a Notice of Draftperson's Patent Drawing Review, PTO-948, is also to be ignored.

¹ The language which is crossed out is contrary to amended 37 CFR 1.85(c) and 1.136. See "Changes to Implement the Patent Business Goals", 65 Fed. Reg. 54603, 54629, 54641, 54670, 54674 (September 8, 2000), 1238 Off. Gaz. Pat. Office 77, 99, 110, 135, 139 (September 19, 2000).